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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,554	12/21/2001	Eldridge R. Byron	SPE-38	1480

7590 08/12/2003

SQUARE D COMPANY
1415 South Roselle Road
Palatine, IL 60067

EXAMINER

LUEBKE, RENEE S

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,554

Applicant(s)

BYRON & ALVAREZ & WALKER &
GROFF

Examiner

Renee S. Luebke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 14 is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The proposed drawing corrections, filed July 7, 2003, are approved by the examiner. These drawings are not seen to be formal drawings because they do not match the format (they are a different size) of the earlier filed set and cannot be inserted thereinto. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

2. The disclosure and drawings are objected to because the specification fails to indicate any operational connection between the LDA and the remainder of the device. As noted by applicant, the LDA "is one individual element" among many in the control center. However, as it is part of a larger device that is fully described, there must be explanation as to how it is connected and how it operates with the other parts.

In addition, the specification includes excessive discussion of features such as the cabinet, fuse holders, etc. that are not the subject of the presently claimed invention. Contrary to applicant's assertions, the excessive description of the other components does not provide context and establish the environment when no mechanical or operational connection between the LDA and the remaining components is discussed. The copending applications (which should be referenced in the present specification) and rights to file future applications are not relevant to the issue of what is appropriate for the specification describing the presently claimed apparatus. Applicant suggests that there are no rules or other restrictions on the length or content of the disclosure. However, while the disclosure may be of any length, it is limited in content. As required by 37 CFR 1.71, "the specification must set forth **the precise invention** for which a patent is solicited" (emphasis added). This

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nonessential subject matter may be better represented if incorporated by reference.

In regard to one objection, applicant has argued that the relationship between the inventive part and the other parts is not important. In regard to another objection, applicant has argued that the detailed discussion of these other parts is very important. These statements are contradictory. Applicant must amend the specification so that it is of similar scope to the claimed invention.

Appropriate corrections are required.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 15-18 remain rejected under 35 U.S.C. 102(b) as being anticipated by Gimeno, et al. This apparatus comprises a means for electrically connecting and earthing 24, means for storing energy 11, means for releasing the stored energy 21, etc., means for compressing the spring 20, means for holding the spring 18, etc., and a means for decompressing the spring.

Contrary to applicant's implications, the examiner has applied 35 USC 112, sixth paragraph, and given the claims their broadest reasonable interpretation in light of the description. The structure of Gimeno, as noted above, is equivalent to the inventive structure that performs the claimed functions. "That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification." (MPEP 2184) Applicant has expressed the opinion that "Gimeno does not teach or suggest the simple structure of the functional elements as taught" in the present application, but has not indicated which claim limitations are not met. Lacking specific

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arguments or evidence, applicant has not met the burden of proof to show nonequivalence. Further, applicant has not overcome MPEP 2184, which requires that "under no circumstance should an examiner accept as persuasive a bare statement or opinion that the element shown in the prior art is not an equivalent embraced by the claim limitation."

5. Claims 1-11 and 14 are allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **It is suggested that responses to this final action be faxed to:**

(703) 872-9319 or 308-7722, 308-7724

Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

For formal communications, please mark "EXPEDITED PROCEDURE."

For informal or draft communications please clearly label "PROPOSED" or "DRAFT."

Alternatively, responses may be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

Hand delivered responses should be brought to:

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.



Renee S. Luebke
Primary Patent Examiner
August 7, 2003